REMARKS

As an initial matter, Applicant sincerely thanks the Examiner for indicating that claims 13 and 80 are allowable.

In the Office Action, claims 4-6, 14-28, 36, 37, 44, 46, 47, 50, 51, 57, 58, 82, 83, 87, 100-102, 109-115, 131-133, 140-146, and 162 were withdrawn from consideration as allegedly being directed to nonelected species. Applicant does not necessarily agree with the Examiner's withdrawal of certain claims that Applicant indicated as "reading" on the elected species as set forth in the Amendment After Final filed March 10, 2003 and the Response to Election of Species Requirement filed March 5, 2002. Nonetheless, since all of the withdrawn claims depend from one of independent claims 1, 64, 75, 98, 129, and 160, which are allowable as will be explained below, Applicant requests the rejoinder and allowance of the withdrawn claims.

By this Amendment, Applicant has added new dependent claims 173-175, which find support at least in the specification at pages 2 and 20, for example.

In the Office Action, the Examiner rejected independent claims 1, 64, 75, 129, and 160, and various dependent claims, under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,132,370 to Capezzuto ("Capezzuto"), and rejected several other dependent claims under 35 U.S.C. §103(a) as being unpatentable in view of either Capezzuto alone or combination with U.S. Patent No. 2,659,919 to McCabe et al. ("McCabe").

Claim 1 recites, among other things, an "applicator member including at least one block formed of at least one absorbent material capable of being at least partially

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compressed." Similarly, claim 129 recites an "applicator member comprising an absorbent material and configured to be at least partially compressed." Claims 64 and 160 recite an applicator device, comprising, among other things, an "absorbent member comprising at least two portions, a first application portion configured to apply the liquid product to a surface to be treated, and a second support portion configured to elastically support the first portion, wherein the first portion . . . has a different density than the second portion." Claim 75 recites an applicator device, comprising, among other things, an "absorbent member [that] is compressible."

Capezzuto is directed to a sealable liquid-dispensing applicator. Referring to Figs. 2 and 3, the Capezzuto reference discloses a squeeze-bottle container 10 having a neck portion 16. A housing 24 having a cylindrical flange 26 is received in the neck portion 16. The cylindrical flange 26 has a radially inward extending mouth portion 28 holding a resilient, absorbent, liquid-permeable membrane 34 and a resilient, abrasion-resistant, liquid-permeable membrane 36.

In the rejection of the claims based on Capezzuto, the Examiner continues to equate the resilient, abrasion-resistant, liquid-permeable membrane 36 to the applicator member recited in claims 1 and 129 and to the first application portion recited in claims 64 and 160. (Office Action at pp. 2 and 3.) Also, the Examiner equates the resilient, absorbent, liquid-permeable membrane 34 of Capezzuto to the second support portion recited in claims 64 and 160. (Office Action at p. 3.)

However, Capezzuto neither discloses nor otherwise suggests that membrane 36 is "formed of at least one absorbent material," as recited in claim 1, and there is no disclosure or suggestion of membrane 36 "comprising an absorbent material," as recited

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in claim 129. Rather, Capezzuto discloses that membrane 34 is absorbent, and not membrane 36. At col. 1, lines 53-57 and at col. 2, lines 64-66, Capezzuto discloses the membrane 36 as being made of a woven or perforated plastic, fiber or sheet material, **not** an absorbent material. Thus, Capezzuto neither discloses nor otherwise suggests an "applicator member . . . formed of at least one absorbent material," as recited in independent claim 1, or an "application member comprising an absorbent material," as recited in independent claim 129, and, therefore, independent claims 1 and 129 are patentably distinguishable from Capezzuto.

As explained above, the membrane 36 taught by Capezzuto is not absorbent. Capezzuto thus fails to disclose or otherwise suggest an "absorbent member comprising . . . a first application portion . . . and a second support portion," as recited in independent claims 64 and 160. Therefore, claims 64 and 160 also are patentably distinguishable from the Capezzuto reference.

At page 11 of the Office Action, the Examiner further asserts that:

> "the Capezzuto reference discloses the membrane 36 being a permeable membrane which may be formed of fabrics of artificial or natural fibers. . . . To an extent, fabrics of natural or artificial fibers, for example, cotton or polyester, inherently have an absorbency property and are capable of absorbing liquid."

Applicant respectfully disagrees with the Examiner's assertions regarding Capezzuto. To begin with, Capezzuto neither discloses nor otherwise suggests that the permeable membrane 36 is made of cotton or polyester. Capezzuto nowhere discloses, either explicitly or implicitly, that the fibers with which the permeable membrane can be made include cotton or polyester and the Examiner provides no basis for asserting otherwise.

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To the extent that the Examiner is relying on principles of inherency to support this assertion, the Examiner has failed to establish that the fibers to which Capezzuto refers are ***necessarily*** either cotton or polyester. To establish inherency, the Examiner must show that "the missing descriptive matter is *necessarily* present" in the reference. *See* M.P.E.P. §2112 (*quoting In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. §2112 (emphasis in original.) There are many fibers that the permeable membrane could be made from and there is nothing in Capezzuto that would suggest to a skilled artisan that the permeable membrane is made of either cotton or polyester. To the contrary, Capezzuto explicitly describes the membrane 34, and **not** the membrane 36, as "absorbent" and made of cotton. This would suggest to skilled artisans that membrane 36 is neither absorbent nor made of cotton. Quite simply, the Examiner has offered no evidence in support of his assertion that Capezzuto teaches or otherwise suggests, either explicitly or inherently, that the membrane 36 is made of fibers of either cotton or polyester. Moreover, the Examiner's conclusory assertion that polyester fibers are "inherently" absorbent also is completely unsupported. Should the Examiner maintain his unsupported assertions that the fibers disclosed by Capezzuto necessarily are cotton or polyester fibers, and further that the Capezzuto fibers are necessarily absorbent, Applicant respectfully requests that the Examiner supply a personal affidavit setting forth specific facts within his personal knowledge that support his assertions regarding Capezzuto, in accordance with 37 C.F.R. § 1.104(d)(2) and M.P.E.P. §2144.03.

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Capezzuto also does not disclose or otherwise suggest that the membrane 36 is either "compressible," as recited in claim 75; "capable of being at least partially compressed," as recited in claim 1; or "configured to be at least partially compressed," as recited in 129. Significantly, the Examiner has not explained in the Office Action how Capezzuto discloses or otherwise suggests that the membrane 36 is compressible or capable of being at least partially compressed. Indeed, this is because Capezzuto contains no such disclosure regarding the compressibility of membrane 36.

Further, with respect to claims 64 and 160, which recite that "the first portion . . . has a different density than the second portion," Capezzuto lacks any disclosure of the relative densities of membranes 34 and 36.

For at least this reason, claims 1, 64, 75, 129, and 160 are patentably distinguishable from the Capezzuto reference.

The Examiner relied on McCabe in combination with Capezutto to reject certain dependent claims. McCabe does not cure the above-noted deficiencies of the Capezzuto reference, and the Examiner has not asserted otherwise in the Office Action. Rather, the Examiner relies on McCabe for its alleged teachings of "a reservoir 12 having a diaphragm portion 14a." Accordingly, the Section 102(b) and 103(a) rejections citing Capezutto should be withdrawn.

Independent claims 64, 75, and 160, as well as several dependent claims, also were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,837,756 to Barlow et al. ("Barlow"), and several other dependent claims were rejected under 35 U.S.C. §103(a) as being unpatentable in view of either Barlow alone or in view of U.S. Patent No. 4,225,253 to Fraleigh ("Fraleigh"). To the extent the rejections of

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claims 64, 75, and 160 may still apply to those claims, as amended, those rejections should be withdrawn for the reasons explained below.

Each of claims 64, 75, and 160 has been amended to recite that the "absorbent member comprises a face that faces toward the reservoir, the face being positioned with respect to the reservoir so as to be loaded with product from the reservoir."

Barlow discloses an ink applicator having an adjustable valve and spreader elements. Referring to Figs. 1-3, Barlow discloses a device 70 including a tube 72 for holding ink to be dispensed, a tube engaging element 74, a valve element 76, and a spreader element 78. A tubular member 86 extends from the tube engaging element 74. The valve element 76 is disposed in the tubular member 86. The spreader element 78 includes a spreading member 98 having a roughened surface and a resilient member 100 with a bore 104 therethrough. The bore 104 engages with projections 88 on the tubular member 86 to maintain the spreader element 78 on the member 86. (Col. 2, lines 51 through col. 3, line 9.) Barlow further describes that in use, fluid is fed directly to the surface to which fluid is to be applied through the resiliently urged ball valve means and when the fluid is dispensed, it may be evenly distributed by the wiping action of the spreading element, in particular the roughened or porous spreader member 98, 98'. (Col. 1, lines 46-52, col. 3, line 43 through col. 4, line 7, and Figs. 2, 4, and 5.)

Barlow fails to disclose or otherwise suggest an absorbent member that has a face that faces toward the reservoir with the face being positioned with respect to the reservoir so as to be loaded with product from the reservoir, as set forth in claims 64, 75, and 160. Instead, Barlow teaches that the product is dispensed through the tubular

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element 86 and thus onto the face 102 of the spreading member 98 that faces away from the tube 72. For at least this reason, therefore, claims 64, 75, and 160, and their respective dependent claims, are patentably distinguishable from Barlow. This is true whether Barlow is taken alone or in combination with Fraleigh since there is no motivation to modify Barlow with Fraleigh so as to cure the above-noted deficiencies of Barlow. Indeed, to do so would destroy the principles of operation of Barlow. Notably, the Examiner did not rely on Fraleigh to cure the above-noted deficiencies of Barlow, but instead for its alleged disclosure of a closure member for sealably closing the opening. (Office Action at p. 8.)

Independent claims 1, 98, and 129, as well as several dependent claims, were rejected under 35 U.S.C. §102(b) as being anticipated by Fraleigh, and several other dependent claims were rejected under 35 U.S.C. §103(a) as being unpatentable over either Fraleigh alone or in view of McCabe. Each of claims 1, 98, and 129 recites a "support having a compressibility greater than the compressibility of the applicator member."

Fraleigh discloses a liquid container and applicator for dispensing paint onto screw heads. Referring to Figs. 2 and 4, Fraleigh discloses a plastic squeeze bottle filled with paint having an externally threaded neck 16. The neck 16 receives an interiorly threaded cap 18 having a central aperture 20. A round applicator tube 24 extends axially from the aperture 20 and is fixed to the flange. The applicator tube 24 defines an open mouth 28 through which a sponge 30 disposed on a compression spring 34 extends. The compression spring 34 is disposed within the tube 24. (Col. 1, line 65 through col. 2, line 29.)

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In use, as shown in Fig. 4, the open mouth 28 is positioned over the screw 40 to be painted. At col. 2, lines 38-40, Fraleigh discloses that the "compression forces of spring 34 squeeze the sponge." As such, Fraleigh teaches that the sponge 30, which the Examiner equates to Applicant's recited applicator member, has a greater compressibility than the spring 34, which the Examiner equates to Applicant's recited support. Thus, Fraleigh fails to disclose or otherwise suggest, and instead teaches the exact opposite of, a "support having a compressibility greater than the compressibility of the applicator member," as required by claims 1, 98, and 129. For at least this reason, claims 1, 98, and 129, and their respective dependent claims, are patentably distinguishable from Fraleigh.

The Examiner relied on McCabe in combination with Fraleigh to reject certain dependent claims. However, McCabe does not cure the above-noted deficiency of Fraleigh and the Examiner does not assert otherwise in the Office Action.

Independent claims 1, 64, 75, 129, and 160, and several dependent claims, also were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 3,266,079 to Schwartzman, and several other dependent claims were rejected under 35 U.S.C. §103(a) as being unpatentable over either Schwartzman alone or in view of McCabe.

Referring to Figs. 2 and 3, Schwartzman discloses a container 12 and a dauber assembly 14 adapted to be permanently attached to the container 12. The dauber assembly 14 includes a valve housing 15 and a disc 20. The disc 20 has a lower layer 23 made of a polyurethane foam and an upper layer 21 formed of a nylon knitted brush fabric. In rejecting the claims based on Schwartzman, the Examiner equated the upper

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layer 21 of disc 20 taught by Schwartzman to Applicant's recited "applicator member" and equated disc 20 to Applicant's recited "support."

Regarding the rejection of claims 1 and 129 based on Schwartzman, Schwartzman fails to disclose or otherwise suggest that the upper layer 21, which the Examiner equates to the claimed "applicator member," is either capable of being or configured to be "at least partially compressed," as recited in claims 1 and 129. There is no disclosure whatsoever in Schwartzman that the upper layer 21 is in any way compressible and the Examiner points to none in the Office Action. For at least this reason, therefore, claims 1 and 129, and their respective dependent claims are patentably distinguishable from Schwartzman.

Regarding the rejection of claims 64, 75, and 160, each of those claims has been amended to recite that the "first portion comprises one of a frit or a foam." As discussed above, Schwartzman discloses that the upper layer 21 is made of a nylon knitted brush fabric. Schwartzman neither discloses nor otherwise suggests that the upper layer 21 is made of either a frit or a foam. For at least this reason, claims 64, 75, and 160, and their respective dependent claims, are patentably distinguishable from Schwartzman.

As noted above, the Examiner relies on McCabe in combination with Schwartzman to reject certain dependent claims. However, McCabe fails to cure the above-noted deficiencies of Schwartzman and the Examiner does not assert otherwise in the Office Action.

As explained above, withdrawn claims 4-6, 14-28, 36, 37, 44, 46, 47, 50, 51, 57, 58, 82, 83, 87, 100-102, 109-115, 131-133, 140-146, and 162 depend from one of claims 1, 29, 64, 75, 98, 129, and 160, respectively, and therefore are allowable for the

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same reasons claims 1, 29, 64, 75, 98, 129, and 160 are allowable. Applicant therefore requests that the withdrawn claims be rejoined and also allowed.

As discussed above, the various dependent claims are allowable for at least the same reasons that the respective independent claim from which each depends is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by the cited art, and therefore also are separately patentable.

The Office Action contains numerous characterizations of the claims and the related art with which Applicant does not necessarily agree. Moreover, and by way of example only, the Examiner makes several conclusory assertions regarding how the related art devices are "capable" of being used, what methods are "inherently" performed using those devices, what is "routine skill in the art," and what "would have been obvious to one of ordinary skill in the art," and provides no support for those assertions. Unless expressly noted otherwise, Applicant declines to subscribe to any statement, characterization, conclusion, or assertion set forth in the Office Action.

Applicant respectfully requests the rejoinder of the withdrawn claims, the withdrawal of the outstanding claim rejections, and the timely allowance of the pending claims 1-175.

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Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: September 29, 2003

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